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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,713	02/11/2004	Patrick M. Cox	41698.1113	2804

7590 12/26/2007  
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New York, NY 10022

EXAMINER
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PATEL, HEMANT SHANTILAL

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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12/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/776,713	Applicant(s) COX ET AL.	
	Examiner Hemant Patel	Art Unit 2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 82, 84-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 82, 84-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 29, 2007 has been entered. Claims 82, 84-99 are pending in this application.

### ***Response to Amendment***

2. Applicant's arguments with respect to claims 82, 84-99 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 87 must be renumbered. The second claim 87 reciting ("ANI") is renumbered as claim 100.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 82, 84-90, 100 (renumbered claim 87) are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 6,456,709 (hereinafter referred to as patent '709). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are broader than the ones in patent '709, *In re Van Ornum and Stang*, 214 USPQ 761, broad claims in continuation application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 82 of the instant application recites the claim limitations of claim 22 (including parent claim 16) of patent '709 except some limitations as follows.

"receiving a call from a caller using a communication device, the call including directory assistance request;" (patent 709, claim 16, receiving a call from the customer on an inbound channel; eliciting a directory assistance request from the customer;)

"in response to the directory assistance request, attempting to establish a telephonic connection between the caller and a destination party;" (patent 709, claim 16, ~~allocating an outbound channel for attempting to establish a connection to a destination telephone associated with the destination telephone number~~)

"detecting a connection status signal concerning an establishment of the telephonic connection; determining that the connection status signal indicates a non-answering condition;" (patent 709, claim 16, ~~detecting a connection status signal on the outbound channel; analyzing by the signal processing device the connection status signal to determine whether the connection status signal is a ring-no-answer signal~~)

"in response to the connection status signal, automatically presenting to the caller an option to receive a telephone number associated with the destination party by pressing a predetermined key on the communication device;" (patent 709, claim 16, ~~when it is determined that the connection status signal is a ring-no-answer signal, automatically transferring the customer to a directory assistance provider while continuing the attempt to establish a connection to the destination telephone over the outbound channel and continuing to monitor the outbound channel using the signal processing device; patent 709 claim 22, further comprising presenting the customer with a menu of directory assistance options, wherein the menu of directory assistance options includes one or more of the following: conveying the destination telephone number to the customer; transmitting the destination telephone number to the customer's alphanumeric communication device; transferring the customer to a directory assistance operator; continuing to monitor the outbound channel using the signal processing device; and recording a message to be delivered to a destination party associated with the destination telephone number~~) and

"providing to the caller the telephone number associated with the destination party when the caller presses the predetermined key on the communication device" (inherent in the providing of the options to collect the caller response and provide the result of this response selection i.e. provide the destination directory number).

But, Claim 82 of the instant application does not recite patent '709 claim 16

(parent of patent '709 claim 22) limitations of searching a database containing telephone

numbers for search results including a destination telephone number that satisfies the directory assistance request; allocating an outbound channel for attempting to establish a connection to destination telephone; monitoring the outbound channel using a signal processing device. The claim 82 of the instant application further does not recite patent '709 claim 22 limitations of presenting the customer with a menu of directory assistance options, wherein the menu of directory assistance options includes one or more of the following: transmitting the destination telephone number to the customer's alphanumeric communication device; transferring the customer to a directory assistance operator; continuing to monitor the outbound channel using the signal processing device; and recording a message to be delivered to a destination party associated with the destination telephone number. Therefore, claim 82 of the instant application is broader than patent '709 claim 22.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 82, 84-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daudelin (US Patent No. 4,959,855).

**Regarding claim 82,** Daudelin teaches of a method to receive a call from a caller to directory assistance service requesting a call set up in which case the caller is not given a telephone number (col. 1, ll. 55-59; asking customer for call set up option but not including directory number of listing; col. 1, ll. 67-col. 2, ll. 10; col. 6, ll. 12-17; col. 7, ll. 48-55; customer requesting call set up) but the call is connected to retrieved destination telephone number and the operator drops out of the call. Daudelin also teaches of giving a telephone number if call setup can not be accomplished (col. 7, ll. 32-36) (refer to Figs. 1-5 and corresponding descriptions). It was obvious to a person of ordinary skill in the art to modify Daudelin to provide the caller with a telephone number, that was not provided to the caller before call set up attempt, in case the call did not go through "so that the customer can dial the call if required". Since the caller had requested only the call set up but not the actual listing number, it was obvious to prompt the caller to provide a choice to get the listing number instead of trying to give the number irrespective of the caller disconnecting the call.

**Regarding claim 84,** Daudelin teaches of providing the alphanumeric message to the caller just as directory assistance service had been doing when calling 411 or

555-1212 directory service i.e. announcing the listing number like "The number is 571-272-9000" as it was well known in the art (col. 7, ll. 48-51 requesting call set up, 32-36 announcing the listing number).

**Regarding claim 85, 86**, it was obvious to modify Daudelin to provide the alphanumeric message i.e. "212-123-4567" to the caller's pager so that it gets stored automatically for later use without any manual effort by the caller, and it was obvious to send it to the paging server of service carrier providing the paging service to transmit it to the pager as was well known in the art.

**Regarding claim 87**, it was obvious to modify Daudelin to provide the alphanumeric message to the wireless telephone of the caller so that it gets stored automatically in the wireless telephone for later use without any manual effort by the caller as was well known in the art.

**Regarding claims 88, 89, 100**, it was obvious to modify Daudelin to provide the alphanumeric message to automatic number identification ("ANI") of the caller so that it gets stored automatically in the personal address book or storage of caller's calling device for later use without any manual effort by the caller as was well known in the art.

**Regarding claim 90**, Daudelin teaches of announcing the listing number to the caller but does not specifically teach its mechanism. But it was well known in the art to verbalize each digit of the telephone number associated with the destination party as directory assistance service had been doing when calling 411 or 555-1212 directory service i.e. announcing the listing number like "The number is 5", pause, "7", pause, "1", pause, "2" ", pause, "7" ", pause, "2" ", pause, "9" ", pause, "0" ", pause, "0" ", pause,



"0" (note: pause is not announced but it is a brief period between digit announcements) as it was well known in the art. This was the way systems were economically designed so that *only 10* different announcement circuits will be required to announce the number of any size.

***Regarding claim 91***, it recites the system that performs a method substantially similar to the method as claimed in claim 82. Duadelin teaches of such a system (Fig. 1 and its corresponding descriptions). Refer to rejection for claim 82.

***Regarding claim 92***, refer to rejections for claim 91 and claim 84.

***Regarding claim 93***, refer to rejections for claim 92 and claim 85.

***Regarding claim 94***, refer to rejections for claim 92 and claim 86.

***Regarding claim 95***, refer to rejections for claim 92 and claim 87.

***Regarding claim 96***, refer to rejections for claim 92 and claim 100 (renumbered old claim 87 reciting "ANI").

***Regarding claim 97***, refer to rejections for claim 92 and claim 88.

***Regarding claim 98***, refer to rejections for claim 97 and claim 89.

***Regarding claim 99***, refer to rejections for claim 91 and claim 90.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel  
Examiner  
Art Unit 2614

HSP

*HSP*

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